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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,162	09/27/2001	Steve E. Hoffman	9436-9	3930

23973 7590 05/22/2003

DRINKER BIDDLE & REATH  
ONE LOGAN SQUARE  
18TH AND CHERRY STREETS  
PHILADELPHIA, PA 19103-6996

EXAMINER

WINDMULLER, JOHN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/22/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/965,162

Applicant(s)

HOFFMAN, STEVE E.

Examiner

John Windmuller

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 7-12, drawn to a method of forming a saw blade, classified in class 451, subclass 32.
  - II. Claims 1-6, 13-18, drawn to an improved saw blade, classified in class 83, subclass 835.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case (1) applies. The method of making the saw blade could be used to make a saw blade with, say, a rougher surface finish than is claimed in invention I.

2. During a telephone conversation with Robert E. Cannuscio on 5/12/03 a provisional election was made without traverse to prosecute invention II, drawn to an improved saw blade, claims 1-6, 13-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, 13, 14, 18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Vankov et al. The device of Vankov et al. discloses the invention as claimed, including, inter alia, a straight blade portion with a plurality of teeth and two opposed sides which define a blade portion width, having a surface finish which is less than approximately 10 Ra (col. 5, lines 56-61; col. 6, lines 14-18; col. 10, lines 33-45), having a surface finish which is approximately 6 Ra or less (col. 6, lines 14-18), the sides of the teeth having a surface finish less than 10 Ra and less than 6 Ra (col. 5, line 65 through col. 6, line 3), a cutting edge and teeth having a cutting tips width that are substantially the same as the blade portion width.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vankov et al. in view of Gakhar et al. The device of Vankov et al. discloses the invention as claimed except

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for an anti-kickback portion coated with a low friction surface located behind each cutting tip.

However, Gakhar et al. teach an anti-kickback portion coated with a low friction surface located behind each cutting tip (Fig. 43, item 14; col. 4, line 67; claim 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Vankov et al. with an anti-kickback portion coated with a low friction surface located behind each cutting tip as taught by Gakhar et al. for less blade binding.

7. Claims 4, 5, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vankov et al. The device of Vankov et al. discloses the invention as claimed except for the surface finish of the blade portion and the sides of the teeth being in a range of between approximately 2 Ra and 6 Ra and in a range of between approximately 2 Ra and 4 Ra. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a surface finish in the ranges specified for better blade performance, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Williams et al. (col. 2, lines 54-58), Ball (claim 13).


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Windmuller whose telephone number is 703 305-4988.

The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703 308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9302 for regular communications and 703 308-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

jw   
May 19, 2003

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700